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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,394	03/30/2001	Joanne Chory	SALKINS.012CP1	8748

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EXAMINER

KEMMERER, ELIZABETH

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/823,394

Applicant(s)

CHORY ET AL.

Examiner

Elizabeth C. Kemmerer, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-22 is/are pending in the application.
- 4a) Of the above claim(s) 13-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 11 and 12 is/are allowed.
- 6) ☐ Claim(s) 1-3 and 6-10 is/are rejected.
- 7) ☐ Claim(s) 4 is/are objected to.
- 8) ☒ Claim(s) 1-4 and 6-22 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-893)
- 2) ☐ Notice of Draftsperson's Patent Involvement and Communication (PTO-948)
- 3) ☐ Information Disclosure Statement(s) filed (PTO-944) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Application, Amendments, And/Or Claims***

The amendment filed 30 June 2003 (Paper No. 10) has been entered in full.

Claim 5 is canceled. Claims 1-4 and 6-22 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restriction***

Newly submitted claims 13-22 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Groups I and II are directed to products that are distinct both physically and functionally, are not required one for the other, and are therefore patentably distinct. Further, the protein of Group I can be prepared by processes which are materially different from recombinant expression of the protein in the genetically engineered plants of Group II, such as by chemical synthesis, by isolation and purification from natural sources, or recombinant expression in non-plant cells (including mammalian and bacterial cells). Additionally, search and consideration of claims 12-22 would present an undue search burden to the USPTO, as they recite limitations that are not found when searching and examining protein claims. For example, polynucleotides,

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promoters, and the plants themselves are not typically found in a search of an isolated protein.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-4 and 6-12 are under examination.

***Withdrawn Objections And/Or Rejections***

The objection to the declaration as set forth at p. 2 of the previous Office Action (Paper No. 9, 27 March 2003) is *withdrawn* in view of the newly submitted declaration (Paper No. 10, 30 June 2003).

The objection to the specification for informalities as set forth at p. 2 of the previous Office Action (Paper No. 9, 27 March 2003) is *withdrawn* in view of the amendment to the specification correcting same (Paper No. 10, 30 June 2003).

The objection to claims 1, 6 and 11 for informalities as set forth at p. 3, second paragraph, of the previous Office Action (Paper No. 9, 27 March 2003) is *withdrawn* in view of the amended claims (Paper No. 10, 30 June 2003).

The objection to claim 12 as being dependent upon a rejected base claim as set forth at p. 3, second paragraph, of the previous Office Action (Paper No. 9, 27 March

2003) is *withdrawn* in view of the allowability of amended claim 11 (see below and Paper No. 10, 30 June 2003).

The rejection of claims 5, 8 and 9 under 35 U.S.C. § 112, second paragraph, as set forth at pp. 3-4 of the previous Office Action (Paper No. 9, 27 March 2003) is *withdrawn* in view of the canceled and amended claims (Paper No. 10, 30 June 2003).

The rejection of claim 11 under 35 U.S.C. § 112, first paragraph, for lack of adequate written description as set forth at pp. 7-8 of the previous Office Action (Paper No. 9, 27 March 2003) is *withdrawn* in view of the amended claims (Paper No. 10, 30 June 2003).

**35 U.S.C. § 112, First Paragraph**

Claims 1-3 and 6-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for substantially purified BIN1 polypeptide comprising a fragment of SEQ ID NO: 2, wherein said fragment binds brassinosteroids, does not reasonably provide enablement for other BIN1 variants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The basis for this rejection is set forth at pp. 4-7 of the previous Office Action (Paper No. 9, 27 March 2003).

Applicant's arguments (pp. 6-7, Paper No. 10, 30 June 2003) have been fully considered but are not found to be persuasive for the following reasons. Applicant points to specific BIN1 substitutional variants (BIN1-104, BIN1-102, BIN1-6, BIN1-116)

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which have detectable binding activity. Applicant points to specific places in the specification wherein these variants are described in terms of structure, as well as assays for binding activity. However, as pointed out in the previous Office Action (p. 5, especially), the specification's discussion of these variants is confusing. The specific contradictions within the specification regarding the variants is discussed at p. 5, lines 1-15, in the previous Office Action. Applicant has not provided clarification regarding these contradictions. Therefore, the rejection is maintained, as the specification does not provide clear guidance regarding how to make and use BIN1 variants other than fragments which bind brassinosteroids.

***Claim Objections***

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Claims 11 and 12 are allowable. Claims 1-4 and 6-10 are not allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth C. Kemmerer, Ph.D., whose telephone number is (703) 308-2673. The examiner can normally be reached on Mondays through Thursdays from 6:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

ECK  
August 25, 2003

*Elizabeth C. Kemmerer*

ELIZABETH KEMMERER  
PRIMARY EXAMINER